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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,736	09/11/2000	James M. Zavislan	ML-0414DIV	3878

7590

06/30/2005

Kenneth J LuKacher  
South Winton Court  
Suite 304  
3136 Winton Road South  
Rochester, NY 14623

EXAMINER
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SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/658,736

Applicant(s)

ZAVISLAN, JAMES M.

Examiner

Ruth S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 19-23, 26-36 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 5 and 7 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 19, 20, 23, 26-36 and 42-48 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,19,26,29,31-33,42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Corcuff et al ("In Vivo Vision of the Human Skin with the Tandem Scanning Microscope"). The claims are directly readable on Corcuff et al which disclose the use of a confocal microscope to provide images representing optically formed sections. Corcuff et al disclose the microscope is modified to limit skin movements using a surface contact device. The surface contact device is considered to be a plate through which light passes. The device will inherently apply force and maintain an area of skin tissue under stress. The device will inherently apply force against at least the edges of the area of skin tissue being examined.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,6,8,19,26-36,42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corcuff et al in view of Dhawan. Corcuff et al disclose the use of a confocal microscope to provide images representing optically formed sections. Corcuff et al disclose the microscope is modified to limit skin movements using a surface

contact device. The device will inherently apply force and maintain an area of skin tissue under stress. The device will inherently apply force against at least the edges of the area of skin tissue being examined. Corcuff et al fails to disclose that the means for maintaining the skin under stress comprises a platen. Dhawan discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. The means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged. The opening in the platen 54 includes a material window as part of element 44 which is considered to be a plate. Placement of the platen with respect to the tissue to be imaged inherently includes the means for moving it into position as set forth in claim 2. It would have been obvious to one skilled in the art to have modified Corcuff et al such that the means for maintaining the skin under stress is as taught by Dhawan. Such a modification involves the substitution of one known means for maintaining the skin under stress by application of force in the environment of an optical imaging camera for another. With respect to claim 6, Corcuff et al discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. Dhawan discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device. In the absence of any showing of unexpected results, the means used to move the head in the modified Corcuff et al device would have been an obvious design choice to one skilled in the art.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corcuff et al in view of Dhawan as applied to claim 2 above, and further in view of Jester et al, "In Vivo, Real-time Confocal Imaging". Jester et al disclose means for fixing the position of the imaging device with respect to an area of the patient before it is lowered into place on the patient. It would have been obvious to one skilled in the art to have further modified Corcuff et al such that it includes means for temporarily fixing the imaging with respect to the patient before it is moved into contact with the tissue. Such a modification allows for more precise positioning and handling of the device. Dhawan

discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device. In the absence of any showing of unexpected results, the means used to move the head in the modified Corcuff et al device would have been an obvious design choice to one skilled in the art.

Claims 20,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corcuff et al in view of Dhawan and Jester et al, "In Vivo, Real-time Confocal Imaging". Corcuff et al which disclose the use of a confocal microscope to provide images representing optically formed sections. Corcuff et al disclose the microscope is modified to limit skin movements using a surface contact device. The device will inherently apply force and maintain an area of skin tissue under stress. The device will inherently apply force against at least the edges of the area of skin tissue being examined. Corcuff et al fails to disclose that the means for maintaining the skin under stress comprises a platen. Dhawan discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. The means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged. The opening in the platen 54 includes a material window as part of element 44. Placement of the platen with respect to the tissue to be imaged inherently includes the means for moving it into position as set forth in claim 2. It would have been obvious to one skilled in the art to have modified Corcuff et al such that the means for maintaining the skin under stress is as taught by Dhawan. Such a modification involves the substitution of one known means for maintaining the skin under stress by application of force in the environment of an optical imaging camera for another. Jester et al disclose means for fixing the position of the imaging device with respect to an area of the patient before it is lowered into place on the patient. It would have been obvious to one skilled in the art to have further modified Corcuff et al such that it includes means for temporarily fixing the imaging with respect to the patient before it is moved into contact with the tissue. Such a modification allows for more precise positioning and handling of the device. Dhawan discloses means for moving

the imaging head with respect to the orifice in that the camera can be inserted into the device. In the absence of any showing of unexpected results, the means used to move the head in the modified Corcuff et al device would have been an obvious design choice to one skilled in the art.

### ***Allowable Subject Matter***

Claims 4,5,7 are allowable over the prior art of record.

Claims 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 4/21/05 have been fully considered but they are not persuasive. The surface contact device disclosed by Corcuff et al appears to comprise a plate through which light passes. Furthermore, modification of Corcuff et al to include the means for maintaining the skin under stress as taught by Dhawan would result in a plate positioned in an orifice of the platen through which light passes.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, overlapping flourish at the end.

Ruth S. Smith  
Primary Examiner  
Art Unit 3737

RSS